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By:



Sarah M. Barnett



PATENT

Customer No. 22,852

Attorney Docket No. 07579-0001-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:

Graham Edmund KELLY

Reissue Application No.: 09/602,191

U.S. Patent No. 5,830,887

Filed: June 22, 2000

For: HEALTH SUPPLEMENTS
CONTAINING PHYTO-
OESTROGENS, ANALOGUES OR
METABOLITES THEREOF

Group Art Unit: 1623

Examiner: Patrick T. Lewis

Confirmation No. 8264

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

EIGHTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. § 1.97(c)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(c), Applicant brings to the attention of the Examiner the documents on the attached listing. This Information Disclosure Statement is being filed after the events recited in Section 1.97(b) but, to the undersigned's knowledge, before the mailing date of either a Final action, Quayle action, or a Notice of Allowance. Under the provisions of 37 C.F.R. § 1.97(c), this Information Disclosure Statement is accompanied by a fee of \$180.00 as specified by Section 1.17(p).

Copies of the listed foreign and non-patent literature documents are attached. Copies of the U.S. patent publications are not enclosed.

Applicant respectfully requests that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

In lieu of a statement of relevance or translation of the non-English documents, an English language version of a search report from the European Patent Office in a corresponding application citing these documents and setting forth the relevance thereof is enclosed.

Previous Information Disclosure Submissions

The Applicant wishes to correct the form of certain references previously submitted with Information Disclosure Statements, but not yet been considered. To accomplish this, the Applicant's representative contacted the Office and wishes to express gratitude to Examiner Lewis and his supervisor, James O. Wilson, for their time during multiple telephone conversations and for their willingness to consider the most expedient manner for addressing these issues. The Applicant now submits the enclosed Information Disclosure Statement to allow consideration of references not previously considered and to submit additional references for consideration. The Applicant notes that U.S. Application No. 10/510,837 is a national-phase filing of PCT application No. PCT/AU 03/000427, which published as WO 03/086386.

The Information Disclosure Statement filed on September 19, 2003, disclosed co-pending applications that might be considered related or possibly related to the instant application. However, the PTO/SB/08 form listed a number of U.S. patent application numbers that the Examiner did not initial. After discussion of this issue with Mr. Lewis and Mr. Wilson, the Applicant's representative realizes that two issues were at hand. First, the application numbers were listed under the heading, "U.S. Patent Documents" and should have been listed under the

heading, "Other Documents." Second, the Office expressed concern that by printing the application numbers on the face of an issued patent, certain confidential information would be disclosed to the public.

The Applicant's representative gratefully acknowledges Mr. Wilson's willingness to reconsider the issue in light of the fact that pending U.S. application numbers are readily available on the public PAIR system, via continuity and patent family searches. There is no issue with confidentiality of the existence of such pending application numbers.

In addition, this submission is in response to the Office communication dated May 5, 2005, in which the Examiner provided instructions on the citation format required for notice of related applications and documents submitted in compliance with the ruling in *Dayco*. The hard copies of the documents previously submitted in compliance with *Dayco* are not submitted again.

The previously submitted documents, which were lined out as "not considered," are resubmitted in the format requested by the Examiner, with the exception of the previously listed, individually submitted, specific documents within an application. These are listed below by date. The items preceded by an asterisk (*) are enclosed herewith:

Restriction Requirement issued in U.S. Patent Application No. 08/338,567 on April 30, 1996 (Attorney Docket No. 07579-0002-00000)
Traversal and Request for Reconsideration filed in U.S. Patent Application No. 08/338,567 on May 31, 1996 (Attorney Docket No. 07579-0002-00000)
Office Action issued in U.S. Patent Application No. 08/338,567 on September 10, 1996 (Attorney Docket No. 07579-0002-00000)
Amendment filed in U.S. Patent Application No. 08/338,567 on February 28, 1997 (Attorney Docket No. 07579-0002-00000)
Second Supplemental Response filed in U.S. Patent Application No. 08/338,567 on March 12, 1997 (Attorney Docket No. 07579-0002-00000)
Preliminary Amendment filed in U.S. Patent Application No. 08/910,837 on August 13, 1997 (Attorney Docket No. 07579-0005-00000)
Office Action issued in U.S. Patent Application No. 08/910,837 on April 2, 1998 (Attorney Docket No. 07579-0005-00000)

Amendment filed in U.S. Patent Application No. 08/910,837 on May 4, 1998 (Attorney Docket No. 07579-0005-00000)
Amendment and Supplemental Request for an Interference filed in U.S. Patent Application No. 08/910,837 on May 18, 1999 (Attorney Docket No. 07579-0005-00000)
Request for Interference filed U.S. Patent Application No. 08/910,837 on June 4, 1998 (Attorney Docket No. 07579-0005-00000)
Office Action issued in U.S. Patent No. 6,146,668 on September 9, 1998 (Attorney Docket No. 07579-0003-00000)
Amendment and Response filed in U.S. Patent No. 6,146,668 on March 8, 1999 (Attorney Docket No. 07579-0003-00000)
Office Action issued in U.S. Patent No. 6,146,668 on June 7, 1999 (Attorney Docket No. 07579-0003-00000)
Office Action issued in U.S. Patent No. 6,340,703 on July 9, 1999 (Attorney Docket No. 07579-0006-00000)
Supplemental Amendment and Supplemental IDS filed in U.S. Patent Application No. 08/910,837 on September 24, 1999 (Attorney Docket No. 07579-0005-00000)
Preliminary Amendment filed in U.S. Patent Application No. 09/421,069 on October 19, 1999 (Attorney Docket No. 07579-0005-02000)
Amendment After Final filed in U.S. Patent No. 6,146,668 on December 7, 1999 (Attorney Docket No. 07579-0003-00000)
Notice of Allowance with Examiner's Amendment issued in U.S. Patent No. 6,146,668 on January 11, 2000 (Attorney Docket No. 07579-0003-00000)
Preliminary Amendment in U.S. Patent Application No. 09/547,100 on April 11, 2000 (Attorney Docket No. 07579-0005-01000)
Preliminary Amendment filed in U.S. Patent Application No. 09/546,565 on April 11, 2000 (Attorney Docket No. 07579-0003-01000)
Office Action issued in U.S. Patent Application No. 09/421,069 on April 17, 2000 (Attorney Docket No. 07579-0005-02000)
Office Action issued in U.S. Patent No. 6,340,703 on April 27, 2000 (Attorney Docket No. 07579-0006-00000)
Office Action issued in U.S. Patent Application No. 09/547,100 on September 13, 2000 (Attorney Docket No. 07579-0005-01000)
Response and Amendment filed in U.S. Patent Application No. 09/421,069 on October 13, 2000 (Attorney Docket No. 07579-0005-02000)
Amendment and Response filed in U.S. Patent No. 6,340,703 on October 27, 2000 (Attorney Docket No. 07579-0006-00000)
Preliminary Motion filed in Interference No. 104,576 on December 19, 2000 (Attorney Docket No. 07579-0005-00000)
Proposed Amendment filed in Interference No. 104,576 on December 19, 2000 (Attorney Docket No. 07579-0005-00000)
Office Action issued in U.S. Patent Application No. 09/421,069 on January 16, 2001 (Attorney Docket No. 07579-0005-02000)

Office Action issued in U.S. Patent No. 6,340,703 on February 9, 2001 (Attorney Docket No. 07579-0006-00000)
Amendment filed in U.S. Patent Application No. 09/547,100 on February 27, 2001 (Attorney Docket No. 07579-0005-01000)
Response filed in U.S. Patent Application No. 09/421,069 on May 15, 2001 (Attorney Docket No. 07579-0005-02000)
Office Action issued in U.S. Patent Application No. 09/547,100 on May 22, 2001 (Attorney Docket No. 07579-0005-01000)
Amendment filed in U.S. Patent No. 6,340,703 on May 31, 2001 (Attorney Docket No. 07579-0006-00000)
Transcript of oral argument for Interference No. 104,576 on June 8, 2001 (Attorney Docket No. 07579-0005-00000)
Proposed Amendment filed in U.S. Patent Application No. 08/910,837 on June 8, 2001 (Attorney Docket No. 07579-0005-00000)
Order Redeclaring Interference issued in U.S. Patent Application No. 08/910,837 on June 20, 2001 (Attorney Docket No. 07579-0005-00000)
Office Action issued in U.S. Patent Application No. 09/421,069 on July 31, 2001 (Attorney Docket No. 07579-0005-02000)
Amendment filed in U.S. Patent Application No. 09/421,069 on August 22, 2001 (Attorney Docket No. 07579-0005-02000)
Office Action issued in U.S. Patent Application No. 09/647,092 on October 23, 2001 (Attorney Docket No. 07579-0013-00000)
Office Action issued in U.S. Patent Application No. 09/421,069 on November 6, 2001 (Attorney Docket No. 07579-0005-02000)
Response filed in U.S. Patent Application No. 09/547,100 on November 20, 2001 (Attorney Docket No. 07579-0005-01000)
Office Action issued in U.S. Patent Application No. 09/547,100 on January 30, 2002 (Attorney Docket No. 07579-0005-01000)
Amendment filed in U.S. Patent Application No. 09/421,069 on February 6, 2002 (Attorney Docket No. 07579-0005-02000)
Amendment filed in U.S. Patent Application No. 09/647,092 on March 25, 2002 (Attorney Docket No. 07579-0013-00000)
Amendment filed in U.S. Patent Application No. 08/910,837 on April 4, 2002 (Attorney Docket No. 07579-0005-00000)
Office Action issued in U.S. Patent Application No. 09/647,092 on June 18, 2002 (Attorney Docket No. 07579-0013-00000)
Amendment After Final filed in U.S. Patent Application No. 09/547,100 on June 28, 2002 (Attorney Docket No. 07579-0005-01000)
Office Action issued in U.S. Patent Application No. 09/986,509 on July 23, 2002 (Attorney Docket No. 07579-0006-01000)
Office Action issued in U.S. Patent Application No. 09/546,565 on October 2, 2002 (Attorney Docket No. 07579-0003-01000)

Preliminary Amendment filed in U.S. Patent Application No. 10/274,371 on October 18, 2002 (Attorney Docket No. 07579-0005-03000)
Office Action issued in U.S. Patent Application No. 09/421,069 on October 22, 2002 (Attorney Docket No. 07579-0005-02000)
Amendment After Final filed in U.S. Patent Application No. 09/647,092 on December 17, 2002 (Attorney Docket No. 07579-0013-00000)
Office Action issued in U.S. Patent Application No. 09/914,035 on December 18, 2002 (Attorney Docket No. 07579-0015-00000)
Amendment filed in U.S. Patent Application No. 09/986,509 on December 23, 2002 (Attorney Docket No. 07579-0006-01000)
Amendment filed in U.S. Patent Application No. 09/421,069 on January 22, 2003 (Attorney Docket No. 07579-0005-02000)
Restriction Requirement issued in U.S. Patent Application No. 09/647,092 on February 10, 2003 (Attorney Docket No. 07579-0013-00000)
Amendment and Response to Restriction Requirement filed in U.S. Patent Application No. 09/647,092 on March 11, 2003 (Attorney Docket No. 07579-0013-00000)
Amendment filed in U.S. Patent Application No. 09/546,565 on April 2, 2003 (Attorney Docket No. 07579-0003-01000)
Notice of Allowance with Statement of Reasons issued in U.S. Application No. 09/647,092 on April 8, 2003 (Attorney Docket No. 07579-0013-00000)
Restriction Requirement issued in U.S. Patent Application No. 09/986,509 on April 18, 2003 (Attorney Docket No. 07579-0006-01000)
Preliminary Amendment filed in U.S. Patent Application No. 10/459,537 on June 12, 2003 (Attorney Docket No. 07579-0013-01000)
Preliminary Amendment filed in U.S. Patent Application No. 10/600,004 on June 18, 2003 (Attorney Docket No. 07579-0015-01000)
Office Action issued in U.S. Patent Application No. 09/546,565 on June 20, 2003 (Attorney Docket No. 07579-0003-01000)
Supplemental Amendment filed in U.S. Patent Application No. 09/421,069 on July 1, 2003 (Attorney Docket No. 07579-0005-02000)
Preliminary Amendment filed in U.S. Patent Application No. 10/611,087 on July 2, 2003 (Attorney Docket No. 07579-0005-04000)
Preliminary Amendment filed in U.S. Patent Application No. 10/611,151 on July 2, 2003 (Attorney Docket No. 07579-0005-05000)
Response to Restriction Requirement filed in U.S. Patent Application No. 09/986,509 on October 8, 2003 (Attorney Docket No. 07579-0006-01000)
Amendment filed in U.S. Patent Application No. 09/546,565 on November 20, 2003 (Attorney Docket No. 07579-0003-01000)
Office Action issued in U.S. Patent Application No. 09/986,509 on February 6, 2004 (Attorney Docket No. 07579-0006-01000)
Office Action issued in U.S. Patent Application No. 09/546,565 on February 25, 2004 (Attorney Docket No. 07579-0003-01000)

*Preliminary Amendment filed in U.S. Patent Application No. 10/799,022 on March 11, 2004 (Attorney Docket No. 07579-0005-06000)
Office Action issued in U.S. Patent Application No. 10/274,371 on May 17, 2004 (Attorney Docket No. 07579-0005-03000)
Office Action issued in U.S. Patent Application No. 10/600,004 on June 17, 2004 (Attorney Docket No. 07579-0015-01000)
Office Action issued in U.S. Patent Application No. 10/611,151 on July 14, 2004 (Attorney Docket No. 07579-0005-05000)
Amendment and Response filed in U.S. Patent Application No. 09/986,509 on August 5, 2004 (Attorney Docket No. 07579-0006-01000)
Amendment filed in U.S. Patent Application No. 09/546,565 on August 25, 2004 (Attorney Docket No. 07579-0003-01000)
Office Action issued in U.S. Patent Application No. 10/611,087 on September 24, 2004 (Attorney Docket No. 07579-0005-04000)
Amendment and Response filed in U.S. Patent Application No. 10/274,371 on October 15, 2004 (Attorney Docket No. 07579-0005-03000)
Notice of Allowance with Examiner's Amendment issued in U.S. Patent Application No. 09/546,565 on November 16, 2004 (Attorney Docket No. 07579-0003-01000)
Amendment filed in U.S. Patent Application No. 10/600,004 on December 13, 2004 (Attorney Docket No. 07579-0015-01000)
Amendment and Response filed in U.S. Patent Application No. 10/611,151 on December 14, 2004 (Attorney Docket No. 07579-0005-05000)
Office Action issued in U.S. Patent Application No. 10/274,371 on January 12, 2005 (Attorney Docket No. 07579-0005-03000)
Amendment filed in U.S. Patent Application No. 09/546,565 on January 26, 2005 (Attorney Docket No. 07579-0003-01000)
*Response to Office Action filed in U.S. Patent Application No. 10/611,087 on March 16, 2005 (Attorney Docket No. 07579-0005-04000)
*Notice of Allowance issued in U.S. Patent Application No. 10/611,151 on March 24, 2005 (Attorney Docket No. 07579-0005-05000)
*Response to Office Action filed in U.S. Patent Application No. 10/274,371 on April 12, 2005 (Attorney Docket No. 07579-0005-03000)
*Final Office Action issued in U.S. Patent Application No. 10/600,004 on April 13, 2005 (Attorney Docket No. 07579-0015-01000)
*Office Action issued in U.S. Patent Application No. 10/611,087 on June 15, 2005 (Attorney Docket No. 07579-0005-04000)
*Notice of Allowance with Examiner's Amendment issued in U.S. Patent Application No. 09/546,565 on June 27, 2005 (Attorney Docket No. 07579-0003-01000)
*Office Action issued in U.S. Patent Application No. 10/459,537 on July 13, 2005 (Attorney Docket No. 07579-0013-01000)
*Notice of Allowance issued in U.S. Patent Application No. 10/274,371 on July 25, 2005 (Attorney Docket No. 07579-0005-03000)

The Office also requests that the Applicant concisely explain the relevance of the specific documents to the patentability of the instantly claimed invention. Office Action at 2. As the Examiner notes, however, "a concise explanation of the relevance of the information is not required for English language information." Office Action at 3. While Applicant appreciates the Examiner's request, Applicant must respectfully decline to provide an explanation of the relevance of each of the documents for reasons already set forth in prior conversations with the Examiner.

Applicant does note, however, that these submissions are made to comply with a conservative reading of the decision by the United States Court of Appeals for the Federal Circuit in *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 U.S.P.Q.2d 1801 (Fed. Cir. 2003). In *Dayco*, the Federal Circuit held that an "adverse decision" by another examiner may meet the materiality standard under the amended Rule 56, and thus, Applicants should disclose prior rejections of "substantially similar claim[s]" to the Office. Accordingly, although Applicant is not representing that the Office Actions in the co-pending applications are material to the present application and is not admitting that any of the other claims are substantially similar, out of an abundance of caution, Applicant has listed and/or provided copies of the substantive Office Actions filed in co-pending applications.

Applicant again most respectfully requests that the Examiner consider these documents to ensure that all possible applicable requirements have been met.

This submission does not represent that a search has been made or that better art exists. It does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claims in the application and Applicant determines that the cited documents do not constitute "prior art" under

United States law, Applicant reserves the right to present to the Office the relevant facts and law regarding the appropriate status of such documents.

Applicant further reserves the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 5, 2005

By: Jean Burke Fordis
Jean Burke Fordis
Reg. No. 32,984

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August 5, 2005

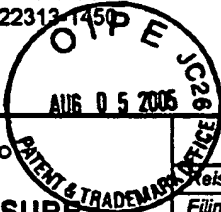
USPS Express Mail Label Number

Date of Deposit

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By: _____

Sarah M. Barnett



IDS Form PTO/SB/08: Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>		Reissue Application No.	09/602,191
		Filing Date	June 22, 2000
		First Named Inventor	KELLY
		Art Unit	1623
		Examiner Name	Patrick T. Lewis
Sheet	1	of	2
		Attorney Docket Number	07579-0001-00000

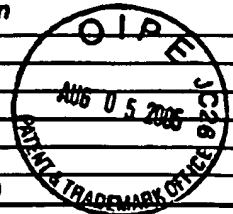
U.S. PATENTS AND PUBLISHED U.S. PATENT APPLICATIONS					
Examiner Initials	Cite No.	Document Number	Issue or Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant - Figures Appear
		Number-Kind Code (if known)			
		USSN 09/546,565	04-11-00	Kelly et al.	
		USSN 10/176,762	06-21-02	Kelly et al.	
		USSN 10/177,387	06-21-02	Kelly et al.	
		USSN 10/181,549	01-22-01	Husband et al.	
		USSN 10/212,847	08-05-02	Kelly et al.	
		USSN 10/250,858	01-16-02	Husband	
		USSN 10/421,659	04-22-03	Kelly	
		USSN 10/469,957	03-08-02	Heaton et al.	
		USSN 10/471,668	03-15-02	Husband et al.	
		USSN 10/493,390	10-25-02	Kelly et al.	
		USSN 10/510,837	10-08-04	Kelly et al.	
		USSN 10/611,151	07-02-03	Kelly	
		USSN 10/636,902	08-06-03	Kelly et al.	
		USSN 10/704,385	11-07-03	Heaton et al.	
		USSN 10/799,022	03-11-04	Kelly	
		USSN 10/851,270	03-20-04	Heaton et al.	
		USSN 10/947,356	09-21-04	Kelly et al.	
		USSN 11/024,512	12-28-04	Kelly et al.	

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Cite No.	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	Translation
		Country Code Number Kind Code (if known)				
		EP 0 682 877 A1	11-22-1995	Nichimo Co. Ltd.		
		EP 0 412 211 A1	02-13-1991	Therapeutical Systems		

Examiner Signature		Date Considered	
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

IDS Form PTO/SB/08: Substitute for form 1449A/PTO		Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Reissue Application No.	09/602,191
		Filing Date	June 22, 2000
		First Named Inventor	KELLY
		Art Unit	1623
		Examiner Name	Patrick T. Lewis
		Attorney Docket Number	07579-0001-00000
Sheet	2	of	2



FOREIGN PATENT DOCUMENTS					
				Corp.	
		JP 02-067218	03-07-1990	Nagakura Seiyaku KK	Abstract
		WO 03/086386	10-23-2003	Kelly et al.	

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	Translation
		Partial European Search Report for EP 04103669, dated December 22, 2004.	

Examiner Signature		Date Considered	
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.